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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,644	01/11/2001	Yoshinobu Makino	2091-0228P-SP	8028

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EXAMINER

KLINGER, SCOTT M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 12/18/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/757,644

Applicant(s)

MAKINO, YOSHINOBU

Examiner

Scott M. Klinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 Jan 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-9 are pending.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119. The certified copy has been filed in parent Application No. JP 2000-002607, filed on 11 January 2000. The effective filing date for the subject matter defined in the pending claims in the application is 11 January 2000.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Dane et al. (WO 99/19811, hereinafter “Dane”). Dane discloses a networked computer system for viewing and ordering prints of photographs. Dane shows:

In referring to claim 1,

- At least one client for generating order information for ordering output of material data (page 6, lines 20-32, “Interactive access to this electronic proofbook allows users and guests to select images for physical prints 310”, see Figure 3)

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- At least one output server for outputting the material data based on the order information (Figure 2, element 20)
- The order information including a pointer for obtaining the material data (a pointer to the material data is inherent in an order for said material)
- The output server obtaining the material data stored at a location other than the output server (Figure 2, the output server 20 obtains the material data from the photographers 16)

In referring to claim 2,

- A relay server existing between at least one client and one output server (Figure 2, shows a relay server 10 between the clients 18 and the output server 20)

In referring to claim 3,

- The relay server comprises servers at a plurality of steps (Figure 2, the relay server 10 connects to multiple servers, including photographers 16, photo finishing lab 20, a bank 26, and a shipping facility 30)

In referring to claim 4,

- The order information is provided to the output server via a network (Figure 2, shows that servers 10, 16, 20 and clients 18 are connected via a network)

In referring to claims 7, 8, and 9,

- Obtaining material data based on the pointer included in the order information (Figure 2, the photo finishing lab 20 obtains the material data from the photographers 16, said material data being referenced by pointers in the order information)
- Outputting the material data that have been obtained (Figure 2, the photo finishing lab 20 outputs the material data)

Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fredlund et al. (U.S. Patent Number 5,666,215, hereinafter "Fredlund"). Fredlund discloses a system and method for remotely selecting photographic images. Fredlund shows:

In referring to claim 6,

- A computer readable recording medium storing order information for ordering output of material data (column 8, lines 51-56, "After the order is prepared, the customer communicates the order to the digital image center 134, either by sending a floppy disc 100 containing the order information to the digital image center, or by communicating the order information over a telecommunication link 40")
- The order information including a pointer to obtain the material data (column 9, lines 2-4, "means of selecting and ordering photographic prints", inherently implies a pointer means to choose desired prints)

In referring to claims 7-9,

- Obtaining the material data based on the pointer included in the order information and outputting the material data that have been obtained (column 8, lines 54-60, "The order is

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filled by accessing the appropriate tape 130 in the tape library 136 to retrieve the applicable high resolution digital image file and driving the appropriate printer 106-110 via the printer server 104 to produce prints 107", inherently implies the access of the applicable digital image file is based on the pointer in the order information)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dane in view of Fredlund.

In referring to claim 5, although Dane shows substantial features of the claimed invention, Dane does not show providing the order information on a computer readable medium. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Dane as evidenced by Fredlund.

In analogous art, Fredlund discloses a system and method for remotely selecting photographic images. Fredlund shows: The order information is provided to the output server by being recorded in a recording medium (column 8, lines 51-56, "After the order is prepared, the customer communicates the order to the digital image center 134, either by sending a floppy disc 100 containing the order information to the digital image center, or by communicating the

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order information over a telecommunication link 40”).

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Dane so as to allow orders to be placed with a computer readable medium, such as taught by Fredlund, in order to allow clients without networking capabilities to be able to use the digital photograph ordering system.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Klinger whose telephone number is (703) 305-8285. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-3183. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Scott M. Klinger  
Examiner  
Art Unit 2153

smk  
8 December 2003

  
GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100